

REMARKS

Status of the claims

Claims 1-34 were presented for examination and were examined on the merits. By virtue of this amendment, claims 1, 2, 7, 8, 25, 26, and 29-33 have been amended and claim 24 has been canceled. Claims 1 and 2 have been amended to recite that the cell is contacted with a polynucleotide encoding a zinc finger protein. Support can be found, for example, at page 7, lines 11-12 of the specification. Claims 7 and 8 have been amended to correct grammatical errors. Claims 25 and 26 have been amended to be consistent with the amendments to claim 1, from which they depend. Claims 29 and 30 have been amended for clarity. Finally, claims 31-33 have been amended to ensure proper antecedent basis, in light of the amendments to claim 1, from which they depend. Following entry of these amendments, claims 1-23 and 25-34 will be pending.

Information Disclosure Statement

The Office Action (§1) states that the IDS filed on March 3, 2003 did not contain a listing of the cited references. In response, Applicants enclose copies of the IDS, Form 1449 and postcard that were mailed on February 24, 2003 and received by the USPTO on March 3, as evidenced by the stamped postcard. As also indicated on the postcard, copies of references listed on the Form 1449 were included in that mailing. Accordingly, Applicants request that the Examiner consider the enclosed copy of the March 3 IDS.

Inventors' Declaration

The Office Action (§2) states that the Inventors' declaration is defective because: (1) it does not list the city and state of residence of each inventor and (2) the signature associated with Alan Wolffe was not identified as that of the legal representative of the deceased inventor.

Applicants note that the signature associated with the name of Alan Wolffe is that of Elizabeth Wolffe, the widow of the deceased inventor and administrator of his estate. Applicants further note that Letters of Special Administration and a Probate Order, both of which appoint Elizabeth Wolffe as Special Administrator of the estate of Alan Wolffe,

were attached to the Declaration that was mailed to the USPTO on December 3, 2001.

Copies of those documents are attached to this response.

Inasmuch as the Office Action states that the missing information can be provided on an application data sheet, such is attached to this response. The attached application data sheet identifies Elizabeth Wolffe as the legal representative of Alan Wolffe under 37 C.F.R. § 1.42, by virtue of her being administrator of his estate, and provides her residence information.

35 USC § 112, first paragraph

Claims 1-24 and 31-34 are rejected under 35 U.S.C. § 112, first paragraph, as it is alleged that the specification does not enable introduction of exogenous zinc finger proteins to cells. Without acknowledging the correctness of this rejection¹, but solely to advance prosecution of the instant application, the claims have been amended to recite delivery of a polynucleotide encoding a zinc finger protein. Accordingly, this rejection can be withdrawn.

Double patenting

Claims 1-8, 10-14, and 25-34 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1-12, 18-22, 25-28, 30-41, 47, 49-51, 54-57, 59-70, 74-78, and 81-84 of US Patent No. 6,534,261. Office Action, paragraph 6. In response, a terminal disclaimer with respect to US Patent No. 6,534,261 is submitted herewith. Accordingly, this rejection can be withdrawn.

Claims 1-8, 10, 11, 14 and 25-34 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims 31, 34-43, 50-54, 57-60 and 62 of copending USSN 09/478,681. Office Action, paragraph 7. Applicants note that USSN 09/478,681 matured into US Patent No. 6,607,882 on August 19, 2003. Consequently, in response, a terminal disclaimer with respect to US Patent No. 6,607,882 is submitted herewith. Accordingly, this rejection can be withdrawn.

¹ Indeed, the patent owner is vigorously opposing a rejection of this type in a related case.

Claims 1, 2-8, 10-12, 14, 24, 31, 32 and 34 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims 118-129, 136-139, 141-152, 159-161, 163-170, 172-174, and 179-183 of copending US Patent Application Serial No. 09/706,243. Office Action, paragraph 8. In response, a terminal disclaimer with respect to USSN 09/706,243 is submitted herewith. Accordingly, this rejection can be withdrawn.

Claims 1-8, 10-12, 14 and 24-34 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1-12, 18-23, 26-29, 31-42, 48-53, 56-59, 61-72, 76-81 and 84-87 of copending US Patent Application Serial No. 09/897,844. Office Action, paragraph 9. In response, a terminal disclaimer with respect to USSN 09/897,844 is submitted herewith. Accordingly, this rejection can be withdrawn.

Claims 1, 12 and 14 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over claims 89, 90 and 92 of copending US Patent Application Serial No. 10/222,614. Office Action, paragraph 10. In response, a terminal disclaimer with respect to USSN 10/222,614 is submitted herewith. Accordingly, this rejection can be withdrawn.

CONCLUSION

Applicants believe that the claims are in condition for allowance and look forward to early notification to that effect. Please address all communications to the undersigned.

Respectfully submitted,

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